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Lawrence J. Merkel
Conley, Rose & Taylor, P.C.
P.O. Box 398
Austin, TX 78767

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Technology Center 2100

In re Application of: McGrath, et al.)
Application No. 09/824,978) DECISION ON PETITION FOR
Attorney Docket No. 5500-66000) SUPERVISORY REVIEW REGARDING
Filed: 04/02/2001) FINALITY OF RESTRICTION
For: MULTIPLE ENTRY POINTS FOR) REQUIREMENT UNDER 37 CFR
SYSTEM CALL INSTRUCTIONS) §1.144

This is in response to the petition filed on December 6, 2004 (duplicate filed on December 29, 2004), under 37 CFR 1.144 requesting supervisory review of the finality of a restriction requirement mailed on October 7, 2004. Note, A petition under 37 CFR §1.144 will not be considered if reconsideration of the requirement was not requested (see §1.181).

The petition is **GRANTED**.

RECENT PROSECUTION HISTORY

- (1) A non-final rejection was mailed on June 4, 2004, in which claims 1-30 were examined.
- (2) A response to the non-final rejection was filed on July 23, 2004, in which claims 6, 16 & 26 were cancelled and claims 31-55 were added.
- (3) A final rejection along with a restriction requirement (by original presentation) was mailed on October 7, 2004, in which claims 31-41 and 43-53 were subject to restriction and/or election requirement. The application was identified to contain the following patentably distinct species: Species 1 (Group I) – drawn to claims 1-5, 7-15, 17-25, 27-30 & 42; Species 2 (Group II) – drawn to claims 31-41; and Species 3 (Group III) – drawn to claims 43-53. The examiner held that since applicant had received an action on the merits for the originally presented invention (i.e. Group I, claims 1-5, 7-15, 17-25, 27-30 and 42), the invention had been constructively elected by original presentation. Accordingly, Groups II and III, claims 31-41 and 43-53, were withdrawn from consideration as being directed to a non-elected invention.
- (4) On October 29, 2004 a response to the final rejection and election requirement was filed in which applicant requested reconsideration of the claims and withdrawal of the election requirement as improper. Applicant provided reasons in support of the request for withdrawal of

the requirement, including a discussion of M.P.E.P. 806.04(f) regarding a proper species restriction.

- (3) On November 23, 2004, the Examiner issued an advisory action, in response to the October 29, 2004 reply. This office action determined the requirement for election to be proper, (therefore considered to be made FINAL).
- (4) On December 6, 2004, the instant petition was filed by Petitioner, under 37 CFR § 1.144.
- (5) A notice of Appeal was filed on January 11, 2005.

RELIEF REQUESTED

The instant petition under 37 CFR 1.144 requests the following relief:

- (1) withdrawal of the election requirement of October 7, 2004 (considered to have been made FINAL on November 23, 2004);
- (2) as a result of item (1), reopening of prosecution on the merits and examination of all pending claims.

ANALYSIS

Petitioner provides various arguments in support of the withdrawal of the election requirement including reference to M.P.E.P. §806.04(f), which states:

Claims to be restricted to different species must be mutually exclusive. The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. This is frequently expressed by saying that claims to be restricted to different species must recite the mutually exclusive characteristics of such species.

In addition, note M.P.E.P. §806.03 sets forth:

Where the claims of an application define the same essential characteristics of a single disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition.

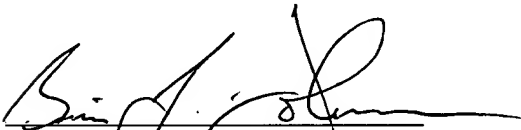
Petitioner states that the claim groups enumerated by the Examiner do not define species having mutually exclusive characteristics under Applicant's disclosure, thus the restriction requirement is improper. A review of the instant application does in fact set forth that the claim groupings identified by the Examiner are related. Petitioner correctly asserts that "mutually exclusive characteristics" is a requirement of the species as described in the disclosure and does not mean that one claim recites a limitation not expressly recited in another claim (as identified by the Examiner). The specification of the instant application provides such interrelation of the identified groupings (see for example Figs. 9-14, specification pages 29-40 and compare claims 1, 11, 21, 31, 42, 43, 48 and 52).

Thus, and in accordance with M.P.E.P. §806.03(f) and §806.04, the species election requirement of October 7, 2003 between Groups I, II and III is deemed to be improper.

The petition is **GRANTED**. The previous action (final rejection) and election requirement is **WITHDRAWN** and a new office action will be forthcoming. Applicant is not required to file an Appeal Brief at this time.

The application is being forwarded to the Examiner for appropriate action i.e. reopening of prosecution on the merits and examination of all pending claims, consistent with this decision.

Any inquiries related to this decision may be directed to the undersigned at (571) 272-3595.



Brian L. Johnson, SPRE
Technology Center 2100

Computer Architecture, Software, and Information Security